



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,024	04/26/2005	Masanori Ogawa	2710/74294	2201
7590 02/14/2008				
Donald S Dowden Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036			EXAMINER NELSON, MICHAEL B	
			ART UNIT	PAPER NUMBER
			4145	
			MAIL DATE	DELIVERY MODE
			02/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,024

Applicant(s)

OGAWA ET AL.

Examiner

MICHAEL B. NELSON

Art Unit

4145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The use of the trademarks has been noted in this application. All trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. *The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.* The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it contains legal phraseology such as "said." Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claims 3 and 9 are objected to because of the following informalities: the claims recites "a *further* rubber and/or elastomer," even though no rubber and/or elastomer had previously been mentioned. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6 and 12 recites the limitation "said rubber and/or elastomer." There is insufficient antecedent basis for this limitation in the claim. To further prosecution, the claims will be interpreted as being dependent on claims 3 and 9 respectively. Appropriate correction is required.
7. Claim 10 recites the limitation "engineering plastic" in line 1. There is insufficient antecedent basis for this limitation in the claim. To further prosecution, the "engineering plastic" will be interpreted to be the same type as the "compatibalized engineering plastic" in line 2 of instant claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Grant et al. (U.S. 4,923,924).

Regarding claim 2, Grant et al. discloses a masking member made of a polymer alloy containing

(See C1 L20-42, the invention is related to the field of masking members,
(trim parts, valve covers etc.))

- a compatibilized engineering plastic and

(See Example 21, Table III, C9, L12-63. CPEC is carboxylated Polyphenylene (C7, L65-67), which is a polyphenylene that has been modified to become more compatible with polyamide by being blended with an ethylenically unsaturated compound containing a carboxylic group and is therefore a compatibilized engineering plastic.)

- a polyamide,

(See Example 21, Table III, C9, L12-63. Nylon 6,6 is a polyamide.)

- wherein said compatibilized engineering plastic and said polyamide are mixed together with a weight ratio of between 20:80 and 80:20.

(See Example 21, Table III, C9, L12-63. The engineering plastic (CPEC) and polyamide (Nylon 6,6) are mixed together at a 50:50 ratio, which is within the instant claimed limitation.)

Regarding claim 9, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking member,

- in which a further rubber and/or elastomer is(are) added to said polymer alloy,

(See Example 21, Table III, C9, L12-63. Kraton G is a hydrogenated styrene-butadiene-styrene polymer which is a rubber.)

- wherein said rubber and/or elastomer is(arc) added to said polymer alloy in an amount of between 1 and 50 parts by weight to 100 parts by weight of the sum of said engineering plastic and polyamide.

(See Example 21, Table III, C9, L12-63. Kraton G is a rubber and is present at 5 parts per weight per 100 parts per weight engineering plastic and polyamide, which is within the instant claimed ranges.)

Regarding claim 10, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking member wherein said engineering plastic is polyphenylene ether or a modified polyphenylene ether.

(See Example 21, Table III, C9, L12-63. CPEC is carboxylated Polyphenylene (C7, L65-67), which is a modified polyphenylene and is an engineering plastic.)

Regarding claim 11, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking wherein said polyamide is nylon6.

(See C5, L30-45, Nylon 6, lines 33-34, is disclosed as one of the polyamides for use in the disclosed invention.)

Regarding claim 12, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking member wherein said rubber and/or elastomer is a styrene-hydrogenated polyolefin-styrene block copolymer.

Art Unit: 1794

(See Example 21, Table III, C9, L12-63. The rubber, Kraton G, is a hydrogenated styrene-butadiene-styrene polymer and butadiene is a hydrogenated polyolefin.)

Claim Rejections - 35 USC § 102/35 USC § 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1, 3-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by, or alternatively under 103(a) as being unpatentable over, Grant et al. (U.S. 4,923,924).

Regarding claim 1, Grant et al. discloses a masking member, which is a molded article manufactured by vacuum and/or pressure forming a sheet made of a polymer alloy containing

(See C1 L20-42, the invention is related to the field of masking members, (trim parts, valve covers etc.))

- an engineering plastic,

(See Example 21, Table III, C9, L12-63. CPEC is carboxylated Polyphenylene (C7, L65-67), which is a modified polyphenylene and is an engineering plastic.)

- a polyamide

(See Example 21, Table III, C9, L12-63. Nylon 6,6 is a polyamide.)

- and a compatibilizer,

(See C3, L43-50. The ethylenically unsaturated compound containing a carboxylic group is blended with the polyphenylene to make it more compatible with the polyamide (C2, L50-C3, L20).)

- wherein said engineering plastic and said polyamide are mixed together with a weight ratio of between 20:80 and 80:20,

(See Example 21, Table III, C9, L12-63. The engineering plastic (CPEC) and polyamide (Nylon 6,6) are mixed together at a 50:50 ratio, which is within the instant claimed limitation.)

- with said compatibilizer being added in an amount of between 0.01 and 50 parts by weight to 100 parts by weight of the sum of said engineering plastic and said polyamide.

(See Example 7, Table I, C8, L3-42. The polyphenylene (PEC) and the ethylenically unsaturated compound containing a carboxylic group, (Maleic Anhydride), which is the compatibilizer, are disclosed as being mixed at 3 parts compatibilizer to 100 parts polyphenylene, which when added to an equal amount of polyamide in Example 21, Table III, C9, L12-63, becomes 1.5 parts compatibilizer to 100 parts engineering plastic and polyamide, which is within the instant claimed range.)

The use of produce-by-process limitations has been noted (i.e. "a molded article manufactured by vacuum and/or pressure forming a sheet..."). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2112.01 [R-1].

Regarding claim 3, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking member,

- in which a further rubber and/or elastomer is(are) added to said polymer alloy,
(See Example 21, Table III, C9, L12-63. Kraton G is a hydrogenated styrene-butadiene-styrene polymer which is a rubber.)
- wherein said rubber and/or elastomer is(are) added to said polymer alloy in an amount of between 1 and 50 parts by weight to 100 parts by weight of the sum of said engineering plastic and polyamide.

(See Example 21, Table III, C9, L12-63. Kraton G is a rubber and is present at 5 parts per weight per 100 parts per weight engineering plastic and polyamide, which is within the instant claimed ranges.)

Regarding claim 4, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking member wherein said engineering plastic is polyphenylene ether or a modified polyphenylene ether.

(See Example 21, Table III, C9, L12-63. CPEC is carboxylated Polyphenylene (C7, L65-67), which is a modified polyphenylene and is an engineering plastic.)

Regarding claim 5, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking wherein said polyamide is nylon6.

(See C5, L30-45, Nylon 6, lines 33-34, is disclosed as one of the polyamides for use in the disclosed invention.)

Regarding claim 6, Grant et al. discloses all of the claimed limitations as set forth above. Additionally the reference discloses a masking member wherein said rubber and/or elastomer is a styrene-hydrogenated polyolefin-styrene block copolymer.

(See Example 21, Table III, C9, L12-63. The rubber, Kraton G, is a hydrogenated styrene-butadiene-styrene polymer and butadiene is a hydrogenated polyolefin.)

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant et al. (U.S.4,923,924) as applied to claims 1 and 2 above, and further in view of Ogawa et al. (JP 2002-187961-A). See English language equivalent (Machine Translation of JP 2002-187961-A).

Regarding claims 8 and 13, Grant et al. discloses all of the claimed limitations as set forth above.

Grant et al. does not disclose a masking member wherein the thickness of said polymer alloy sheet is between 0.1 and 1.5mm.

Ogawa et al. does disclose a masking member wherein the thickness of said polymer alloy sheet is between 0.1 and 1.5mm.

(See [0007], lines 10-14. The sheet has a thickness of between 0.1 and 1.5mm which exactly overlaps the claimed limitation.)

Furthermore, Ogawa et al. discloses that the particular film thickness has improved disruptive strength ([0017], lines 8-9).

Both Grant et al. and Ogawa et al. disclose inventions drawn to the field of masking members and therefore it would have been obvious to one having ordinary skill in the arts at the time of the inventions to have modified the masking member as taught by Grant et al. by giving the sheet the thickness taught by Ogawa et al. for the purposes of imparting improved disruptive strength.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571)270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on (571) 272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MN/
02/01/08

/Gwendolyn Blackwell/
Primary Examiner, Art Unit 1794